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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,699	08/31/2001	Akinori Iwase	016907-1275	9335

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EXAMINER

GOLD, AVI M

ART UNIT PAPER NUMBER

2157

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/942,699	Applicant(s) IWASE ET AL.	
	Examiner Avi Gold	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-38 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 29-38 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/12/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the amendment filed on September 8, 2005. Claims 29-38 were added. Claims 14-28 were cancelled. Claims 29-38 are pending.

Response to Amendment

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 29-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Singhal, U.S. Patent No. 6,256,666.

Singhal teaches the invention as claimed including a method and system by which a user may use a low-capability device to direct a software agent to process and deliver large or complex documents embedded inside an electronic mail document (see abstract).

Regarding claim 29, Singhal teaches a network system comprising a first apparatus, a second apparatus, and a printing device, wherein the first apparatus comprises:

a first interface configured to transmit data to a mobile terminal (col. 4, lines 31-35, Singhal discloses a Mobile Access Gateway and Mobile Access Network);

a second interface configured to transmit data via a network (col. 4, lines 31-35, Singhal teaches data transmitted over a Mobile Access Network), and

a storage destination specifying database configured to store information indicative of a folder provided in a memory of the second apparatus in association with the mobile terminal (col. 5, lines 17-25, Singhal discloses the mobile Message Processor managing the ACMs which include storage locations);

a database configured to separately store data for transmission and information indicative of data for storage among data addressed to the mobile terminal, the data for transmission being to be transmitted to the mobile terminal, the data for storage being not to be transmitted to the mobile terminal (col. 4, lines 57-63, Singhal discloses a filter within the Mobile Access Gateway which allows data for transmission to be sent and filters out the data for storage, i.e. attachments); and

a controller having a function for, when data destined for the mobile terminal received via the network includes data for storage, transmitting data for transmission destined for the mobile terminal and a notification of existence of the data for storage to the mobile terminal, and a function for transmitting the data for storage which is managed in the database and the information indicative of the folder which is stored in the storage destination specifying database and is provided in the memory of the second apparatus in association with the mobile terminal, to the second apparatus in response to a request for storage which is made by the mobile terminal after the mobile

terminal receives the data for transmission (col. 5, lines 8-25, 40-57, Singhal discloses the Attachment Control Message (ACM) working with the Mobile Message Processor (MMP) to store attachments and transmit stored data to a printer),

the second apparatus comprises:

a third interface configured to transmit data to the first apparatus (col. 6, lines 29-33, Singhal discloses MMP forwarding a message to the email server);

a fourth interface configured to transmit data to the printing device (col. 5, lines 40-53, Singhal discloses stored data sent to a printing device);

the memory providing a folder represented by information stored in the storage destination specifying database of the first apparatus (col. 5, lines 17-25, 54-57, Singhal discloses an email server memory and storage related to the ACM and MMP);

a controller having a function for storing the data for storage received from the first apparatus in a designated folder of the memory, when the data for storage and the information indicative of the folder are received from the first apparatus, and a function for transmitting the data for storage stored in the folder of the memory to the printing device through the forth interface in response to a request for transmission which is made by the printing device (col. 5, lines 17-25, 40-53),

the printing device comprises:

a fifth interface configured to transmit data to the second apparatus (col. 5, lines 49-53, Singhal discloses that a printer can be a fax machine);

a controller which requests the second apparatus to transmit the data for storage stored in the folder provided in the memory of the second apparatus (col. 5, lines 8-25, 40-57); and

a printing section which prints the data for storage received from the second apparatus in response to the request for transmission which is made by the controller (col. 5, lines 46-57, Singhal discloses data being printed).

Regarding claim 30, Singhal teaches the network system according to claim 29, wherein the data for transmission is text of an e-mail, and the data for storage is an attached file of an e-mail (col. 4, lines 57-63).

Regarding claim 31, Singhal teaches the network system according to claim 29, wherein

the printing device further comprises an input section which inputs information (col. 5, lines 40-57);

the controller of the printing device requests the second apparatus to transmit the data for storage based on the information input by the input section for specifying the folder provided in the memory of the second apparatus (col. 5, lines 40-57).

Regarding claim 32, Singhal teaches the network system according to claim 31, wherein the data for transmission is text of an e-mail, and the data for storage is an attached file of an e-mail.

Regarding claim 33, Singhal teaches the network system according to claim 29, wherein

the printing device further comprises a display section which displays information (col. 5, lines 40-57);

the controller of the printing device requests the second apparatus to transmit a list of the data for storage in accordance with the information for specifying the folder provided in the memory of the second apparatus input by the input section, causes the display section to display the list of the data for storage received from the second apparatus, and requests the second apparatus to transmit data for storage selected from the list displayed on the display section (col. 5, lines 40-557).

Regarding claim 34, Singhal teaches the network system according to claim 33, wherein the data for transmission is text of an e-mail, and the data for storage is an attached file of an e-mail (col. 4, lines 57-63).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singhal further in view of Sivula, U.S. Patent No. 6,795,711.

Singhal teaches the invention substantially as claimed including a method and system by which a user may use a low-capability device to direct a software agent to process and deliver large or complex documents embedded inside an electronic mail document (see abstract).

As to claim 35 Singhal teaches a network system comprising a first apparatus, a second apparatus, and a printing device, wherein the first apparatus comprises:

- a first interface configured to transmit data to a mobile terminal (col. 4, lines 31-35);

- a second interface configured to transmit data via a network (col. 4, lines 31-35),
and

- a storage destination specifying database configured to store information indicative of a folder provided in a memory of the second apparatus in association with the mobile terminal (col. 5, lines 17-25);

- a database configured to separately store data for transmission and information indicative of data for storage among data addressed to the mobile terminal, the data for transmission being to be transmitted to the mobile terminal, the data for storage being not to be transmitted to the mobile terminal (col. 4, lines 57-63); and

- a controller having a function for, when data destined for the mobile terminal received via the network includes data for storage, transmitting data for transmission

destined for the mobile terminal and a notification of existence of the data for storage to the mobile terminal, and a function for transmitting the data for storage which is managed in the database and the information indicative of the folder which is stored in the storage destination specifying database and is provided in the memory of the second apparatus in association with the mobile terminal, to the second apparatus in response to a request for storage which is made by the mobile terminal after the mobile terminal receives the data for transmission (col. 5, lines 8-25, 40-57),

the second apparatus comprises:

a third interface configured to transmit data to the first apparatus (col. 6, lines 29-33);

a fourth interface configured to transmit data to the printing device (col. 5, lines 40-53);

the memory providing a folder represented by information stored in the storage destination specifying database of the first apparatus (col. 5, lines 17-25);

a storage destination specifying database configured to store information indicative of a folder corresponding to the account name (col. 5, lines 17-53);

a controller having a function for storing the data for storage received from the first apparatus in a designated folder of the memory, when the data for storage and the information indicative of the folder are received from the first apparatus, and a function for transmitting the data for storage stored in the folder which is specified by the storage destination specifying database and corresponds to an account name, in response to a

request for transmission which is made by the printing device (col. 5, lines 17-25, 40-53),

the printing device comprises:

a fifth interface configured to transmit data to the second apparatus (col. 5, lines 49-53);

an input section (col. 5, lines 40-57);

a controller which requests the second apparatus to transmit data (col. 5, lines 8-25, 40-57); and

a printing section which prints the data received from the second apparatus in response to a request for transmission which is made by the controller (col. 5, lines 46-57).

Singhal fails to teach the limitation further including a database for authentication and authentication data being input.

However, Sivula teaches adapting messaging content between different types of mobile terminal stations with minimal need for signaling (see abstract). Sivula teaches the use of data being transmitted to a mobile station after authentication and that authentication data being stored in a database after being input (col. 6, line 34 – col. 7, line 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Singhal in view of Sivula to use authentication processing. One would be motivated to do so because it allows for the data to only be sent to whom it is meant for.

Regarding claim 36, Singhal teaches the network system according to claim 35, wherein the data for transmission is text of an e-mail, and the data for storage is an attached file of an e-mail (col. 4, lines 57-63).

Regarding claim 37, Singhal teaches the network system according to claim 35, wherein

the printing device further comprises a display section which displays information (Singhal, col. 5, lines 40-57);

the controller of the printing device requests the second apparatus to transmit a list of data for storage stored in the folder corresponding to the authentication data in accordance with the authentication data input by the input section, causes the display section to display the list of the data for storage received from the second apparatus, and requests the second apparatus to transmit data for storage selected from the list displayed on the display section (Singhal, col. 5. lines 40-57; Sivula, col. 6, line 34 – col. 7, line 7).

Regarding claim 37, Singhal teaches the network system according to claim 37, wherein the data for transmission is text of an e-mail, and the data for storage is an attached file of an e-mail (col. 4, lines 57-63).

Response to Arguments

5. Applicant's arguments with respect to claims 29-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,714,133 to Hum et al.

U.S. Pat. No. 6,801,962 to Taniguchi et al.

U.S. Pat. No. 6,434,405 to Sashihara

U.S. Pat. No. 6,690,950 to Takagi et al.

U.S. Pat. No. 6,198,783 to Campana, Jr.

U.S. Pat. No. 6,782,419 to Tobita et al.

U.S. Pat. No. 6,304,898 to Shiigi

U.S. Pat. No. 6,157,945 to Balma et al.

U.S. Pat. No. 6,798,715 to Kubo et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 571-272-4002.

The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

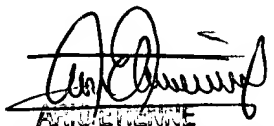
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold

Patent Examiner

Art Unit 2157

AMG


ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100